

### Remarks

Claims 1-32 are pending in the application. All claims stand rejected. By this paper, claims 1-8, 11-17, 19, 20, and 25-32 have been amended. Claims 3-5 and 22-24 have been canceled. New claims 33-36 have been added. Reconsideration of all pending claims herein is respectfully requested.

Claims 1-4, 6, 9-17, 19, 21-23, 25, and 28-32 were rejected under 35 U.S.C. 102(a/e) as being anticipated by Croy et al. ("Croy"). Claims 5 and 24 were rejected under 35 U.S.C. 103(a) as being unpatentable over Croy in view of Schindler. Claims 7, 8, 26, and 27 were rejected under 35 U.S.C. 103(a) as being unpatentable over Croy in view of Gudorf. Claims 18 and 20 were rejected under 35 U.S.C. 103(a) as being unpatentable over Croy. These rejections are respectfully traversed.

Claim 1 has been amended to include the limitations of canceled claims 3 and 4. As amended, claim 1 recites an apparatus for providing e-mail notification to a user of an interactive television system, comprising:

a customer premise equipment capable to receive an e-mail message from a data communication network and transmit an alert signal in response to receiving the e-mail message; and

a remote control device for the interactive television system to receive the alert signal and to provide notification to a user in response to the alert signal without displaying the e-mail message.

In the Office Action, the Examiner argued that the "electronic mail" limitation of claim 4 (now incorporated into claim 1) is disclosed by Croy. However, the referenced passage of Croy only states (in relevant part):

[t]hough primarily intended for EPG use (electronic program guide), the PN 200 can be beneficial in a lot of applications as standard user-interface. Examples are given as follows:

(1) TV, VCR, music radio (EPG): scheduling, navigating, programming, service ordering, such as video on demand (VOD), near video on demand (NVOD), pay per view (PPV), impulse pay per view (IPPV), and other services;

(2) remote control (RC) for different TV sets, VCR's, satellite receivers, high fidelity (HI-FI) equipment, set-top boxes, and the like;

(3) terminal for "net-global" and personal messages, uni/bi-directional, *email*, home banking, home shopping, service ordering and the like;

Column 9, lines 19-30 (emphasis added).

That Croy's personal navigator may be "beneficial in a lot of applications" including e-mail is not an enabling disclosure that may serve as prior art against the claimed invention. How is the personal navigator to be used in e-mail applications? What information is actually displayed on the personal navigator as opposed to a television screen connected to the base station? Croy provides no clues.

Croy does refer several times to "messages" in connection with FIGs. 5-11. However, these messages are never referred to as e-mail messages. Indeed, in connection with FIG. 6, Croy variously refers to messages addressed to base stations and groups of base stations, or broadcast to all base stations. E-mail messages are not typically addressed to base stations or groups of base stations, but, rather, to users. Furthermore, Croy refers to messages that automatically update the firmware of the base station. These are clearly utility or maintenance messages, not e-mail messages.

At the very least, Croy does not disclose using the personal navigator for notifying a user of an e-mail message, as required by amended claim 1. For example, Croy does not teach or suggest illuminating an LED or displaying an indicator on the personal navigator's LCD screen. Indeed, Croy does not even teach

that e-mail messages are actually displayed on the personal navigator. It is just as likely that the personal navigator is simply used to read and compose e-mail on the television screen using the directional buttons of FIG. 3A as is known in the art.

The Examiner argues with regard to claim 25 that the "immediate" display of one of Croy's messages constitutes a "notification." However, if this is true, the notification is not provided "without displaying the e-mail message" as required by amended claim 1. The claimed remote control device may be implemented inexpensively since actual display of messages is not required. A low-cost LED, as recited in new claim 33, may be used to notify the user of an incoming message received by a set top box (STB). Moreover, Croy's alleged "notification" by displaying the message is undesirable where the user is not constantly looking at the remote control (which is almost never the case). Users of interactive television systems are typically watching the main television screen. Thus, requiring the actual display of a message to provide a notification actually teaches away from the claimed sound and vibration notifications.

To establish "anticipation under 35 U.S.C. 102, *the reference must teach every aspect of the claimed invention either explicitly or impliedly.*" MPEP 706.02(a) (emphasis added). In this case, Croy does not disclose e-mail notification using a remote control for an interactive television system, as required by amended claim 1. Croy's reference to his personal navigator being used as a "standard interface" for a variety of applications including e-mail is non-enabling. At the very least, Croy does not disclose e-mail notification without displaying the e-mail message. None of the other references cited by the Examiner cure these deficiencies. Accordingly, claim 1

is believed to be patentably distinct. Claim 19 has been amended to include similar limitations and is likewise believed to be patentably distinct for at least the same reasons.

Claim 28 has been amended to include the limitations of canceled claims 3 and 5. As amended, claim 28 recites an article of manufacture, comprising:

a machine-readable medium having stored thereon instructions to: receive, by a customer premise equipment, an instant message from a data communication network;

in response to the received instant message, send an alert signal to a remote control device for an interactive television system; and

in response to the alert signal, provide notification by the remote control device about the received instant message without displaying the instant message.

In the Office Action, the Examiner argued that the "instant message" limitation of claim 5 (now incorporated into claim 28) is obvious in view of Croy and Schindler. However, Schindler merely discloses a standard interface for a computer "chat room." The interface is displayed exclusively on a computer monitor. Thus, any user notification of an instant message, if there was one, would be shown on the monitor, not on the claimed remote control device.

As argued above, Croy does not disclose user notification via the personal navigator of incoming e-mail or any other type of message, such as an instant message. At the very least, Croy does not disclose user notification without displaying the associated message. Croy provides no disclosure whatsoever for how the personal navigator might be used in e-mail applications and the like and is thus non-enabling.

In addition, Schindler's "chat room" metaphor is inconsistent with the claimed alerts and resulting notification. There is no need to generate an alert in Schindler because users are continually entering and leaving the chat room. There is no explicit notification. Even if the updated list of users in the room could be construed as a "notification," which would be a stretch, the notification could hardly be said to be the result of the claimed alert. There is simply no urgency in a chat room environment in which people come and go, and Schindler provides no teaching or suggestion for the claimed alerts and notifications.

Even if the references were combined, the combination would not result in the claimed invention. At best, one would be combining Croy's non-enabling teaching of using his personal navigator in some undefined way for e-mail with Schindler's computer-based chat room that does not provide user alerts and notifications.

Finally, the Examiner has pointed to no motivation within the references for the proposed combination. "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." *In re Mills*, 916 F.2d 680 (Fed. Cir. 1990); see also MPEP § 2143. Even if all the elements of claim are disclosed in the various prior art references, the claimed invention taken as a whole cannot be said to be obvious without some reason given in the prior art why one of ordinary skill would have been prompted to combine the teachings of the references to arrive at the claimed invention.

Croy does not suggest the desirability or even the possibility of incorporating instant message notification into his personal navigator. Indeed, Croy's non-enabling

disclosure is completely silent about how his personal navigator may be used for e-mail, much less for instant messaging. Schindler does not suggest the desirability or even the possibility of displaying a chat room on a portable device, such as Croy's personal navigator. The Examiner's reference to "increasing the information available to the user" appears to be hindsight reconstruction based on the applicants' own teachings or at least have generic applicability to all information technology inventions. There must be some positive, concrete evidence which gives a logical reason that justifies a combination of primary and secondary references. In re Laskowski, 10 USPQ2d 1397 (Fed. Cir. 1989). Croy and Schindler do not suggest or provide motivation for their combination.

In view of the foregoing, claim 28 is believed to be patentably distinct. Claim 29 has been amended to include similar limitations and is likewise believed to be patentably distinct for at least the same reasons.

Claims 30 and 31 have been amended to incorporate both "e-mail" and "instant messaging" limitations. The applicants respectfully submit that these claims are no broader than claims 1 and 29, which individually recite the two types of messages.

Furthermore, claim 31 recites the limitation that the notification device includes a first visual indicator to notify the user of an incoming e-mail message and a second visual indicator to notify the user of an incoming instant message. None of the references, alone or in combination, disclose two different visual indicators to notify a user about the type of an incoming message (e.g., e-mail vs. instant message). New claims 35 and 36 provide similar limitations in combination with claim 1. For

example, claim 36 recites that the remote control device "includes a first LED for providing the notification of the e-mail message and a second LED for providing the notification of the instant message." None of the cited references disclose or suggest a remote control device with two LEDs used for these distinct purposes.

In view of the foregoing, all independent claims, as amended, are believed to be patentably distinct. All dependent claims are also believed to be patentably distinct by virtue of their dependency on one of the respective independent claims. A Notice of Allowance is respectfully requested.

Respectfully submitted,

Digeo, Inc.

By



Kory D. Christensen  
Registration No. 43,548

STOEL RIVES LLP  
One Utah Center Suite 1100  
201 S Main Street  
Salt Lake City, UT 84111-4904  
Telephone: (801) 328-3131  
Facsimile: (801) 578-6999